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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,611	08/07/2006	Kazuo Hattori	HATTORI 3	9229
1444 7590 03/23/2010 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			EXAMINER DAVIS, ZINNA NORTINGTON	
			ART UNIT 1625	PAPER NUMBER
			MAIL DATE 03/23/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

1. Claims 1-21 are pending in the application.
2. Claims 22 and 23 have been canceled.
3. Based upon the response filed January 19, 2010, the rejections based upon 35 U.S.C. 112, 2nd paragraph and 35 U.S.C. 102(b) based upon Behrens and Izumi et al. are withdrawn.
4. The indicated allowability of claims 4-7 and 13-18 is withdrawn.
5. The indicated allowability of the claims is withdrawn in view of the new rejections which appear below.
6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-18 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, claims 1-18 and 21 are rejected due to claiming a “prodrug” of a compound of Formula (I). The instant specification defines prodrug at page 31, paragraph [0066] which is enzymatically or nonenzymatically converted to the compound represented by the formula (i) or a pharmaceutically acceptable salt thereof under physiological conditions. When such a prodrug is administered to a patient, it may be inactive. According to Wikipedia,

prodrugs can be classified into two types based on their sites of conversion into the final active drug form: Type I, those that are converted intracellularly (e.g., anti-viral nucleoside analogs, lipid-lowering statins, antibody-directed/gene-directed enzyme prodrugs [ADEP/GDEP] for chemotherapy), and Type II, those that are converted extracellularly, especially in digestive fluids or the systemic circulation (e.g., etoposide phosphate, valganciclovir, fosamprenavir). Both types can be further categorized into subtype A or B, based on additional criteria. Those for the Type IA and IB are whether or not the cellular converting location is the site of therapeutic action. For the Type IIA and IIB, they are categorized depending on whether the conversion occurs in the gastrointestinal (GI) fluids or systemic circulation. At page 2, see Wu et al (cited by the Examiner). The scope of prodrug thereof is beyond the examples described in the instant specification. Therefore, such "prodrug" of the Formula (I) is not described in the specification to reasonably convey one skilled in the art, and fails to comply with the written description requirement.

8. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At claim 19, what substituents are intended for the radical, A. Clarification is appreciated.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

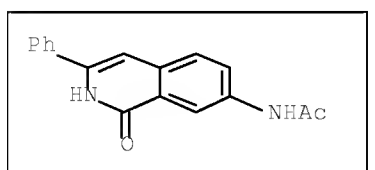
A person shall be entitled to a patent unless --

Art Unit: 1625

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 8, and 15-18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yagi et al. (Reference AD, cited by Applicants on October 10, 2006).

The instantly claimed compound is disclosed. At page 52, Table 1, see the first named compound. The compound is depicted below:



The claims are fully met when X is aryl; Y¹, Y² and Y⁴ are H; Y³ is -NR¹R²; R¹ is H; R² is -C(O)R⁴; and R⁴ is Me.

11. Claim 20 is objected to.

12. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 1625

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna Northington Davis whose telephone number is 571-272-0682.

15. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Zinna Northington Davis/
Zinna Northington Davis
Primary Examiner
Art Unit 1625